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PATENT APPEALS
INTERFERENCES

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue application of:

Freeman et al.
Serial No.: 08/335,981 Group Art Unit: 3302
Filed: November 8, 1994 Examiner: Michael A. Brown
For: U.S. Patent 5,088,484

In re Freeman et al.
Reexamination Proceeding
Control Number. 90/003,586
Filed: October 3, 1994
For: U.S. Patent 5,088,484
Title: ORTHOPEDIC CASTING BANDAGE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

I, Francis A. Paintin, Registration No. 19,386, certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

On April 17, 1997
Francis A. Paintin
Francis A. Paintin Reg. No. 19,386

BOX RE-EXAM

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

SUPPLEMENTAL REPLY BRIEF

Introductory Statement

The Supplemental Answer filed by the Examiner herein is not authorized by 37 CFR §1.193. An analysis of its comments shows that it largely comprises arguments that were made or could have been made in the Examiner's Answer. It is believed to be an unauthorized paper that should not be considered by the Board in rendering its decision; if the Board agrees, this Supplemental Reply Brief can also be ignored. However, insofar as the

Supplemental Answer is considered by the Board, fairness requires consideration of the instant Supplemental Reply Brief.

Response to Supplemental Answer

The Supplemental Answer states:

Appellant argues that Buese does not disclose whether the coloring agent is applied while to the fabric is the soft "state". However, when the coloring agent is applied is a method step that was not given weight in the article claims.

The complete limitation of appellant's claim 1 is that the coloring agent be "stably retained by the fibrous tape while the tape is in a soft state"; the limitations of claims 8, 15 and 24 are similar. The key is **stability** of the coloring agent and, therefore, the article itself, and not merely the presence of just any coloring agent that might not be stable. The limitations add weight to the patentability of the article claims as a valuable property thereof.

The Supplemental Answer also states:

Appellant argues that there is no date provided to determine when two dyes were incorporated into Ace bandages. However, as was set forth in the Final rejection, Ace bandages are old and well known in the bandages art. Ace bandages have always had a dye impregnated into them. However, "Ace" is also impregnated into the bandage to indicate the type of bandage. The Gasper reference point out that the bandage used is an "Ace" bandage.

It is surprising that neither the reexamination requester nor the Examiner has produced any documentation of the time at which Ace allegedly began using a coloring agent in their commercial bandages. Dates are critical in the determination of what is or is not prior art. Nevertheless, it is safe to say that there is

no evidence at all that the stability requirements of appellant's article and method claims are met by use of an Ace bandage or any other cited prior art.

Although the "Ace" bandage may have a distinctive color, neither the reexamination requester nor the Examiner has established whether or not the color is caused by a dye in the fiber before the tape is constructed, or if the color is "disposed on at least a portion of the tape" as required by claim 1, or "bound to a portion of the fibrous tape" as required by claims 15 and 24, or by "using a sublimable dye" as required by claim 25, or by "transfer printing" as required by claim 31. All these claim limitations are important and none has been dealt with by what the "Ace" bandage really is and when was its first effective date.

It is respectfully suggested that all the rejections be reversed and that all claims on appeal be allowed.

Respectfully submitted,



Francis A. Paintin
Registration No. 19,386

Date: *April 17, 1997*

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Certificate of Service

As required by 37 CFR §1.550(e), a true copy of this paper has been forwarded this date by first-class mail to the reexamination requester at the following address:

John R. Schiffhauer
2200 Sand Hill Road, Suite 100
Menlo Park, CA 92025

Date April 17, 1997

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